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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,465	06/05/2001	David O'Hagan	P66645US0	5256
136	7590	05/07/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			DAVIS, BRIAN J	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/857,465	<b>Applicant(s)</b> O'HAGAN, DAVID	
	<b>Examiner</b> Brian J. Davis	<b>Art Unit</b> 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Clarification***

For clarity of the record, **the examiner respectfully suggests that the formal status of claims 1-10 and 12-14 remains withdrawn, rather than canceled**, despite the fact that applicant's most recent listing of claims refers to claims 1-10 and 12-14 as canceled. The record does not indicate that the claims have been formally canceled.

### ***Claim Objections Withdrawn***

The objection to claim 22, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment supplies a period after the structure.

### ***103 Rejections Withdrawn***

The rejection of claims 11 and 22, in so far as they read on the elected species, under 35 USC 103(a), outlined in the previous Office Action, is withdrawn. Applicant's arguments have been carefully considered and are persuasive.

### ***Allowable Subject Matter***

The elected species and its obvious variant are deemed free of the prior art, therefore claim 22, drawn exclusively to the elected species, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims. The obvious variant is defined when the alkyl phenyl moiety to the left of the -NH<sub>2</sub> group ('left' according to applicant's diagram of the elected species in claim 22) is Ph(CH<sub>2</sub>)<sub>2</sub>- rather than PhCH<sub>2</sub>-. All other moieties are as in the elected species. The search was therefore expanded as called for under current Office Markush practice, a compound-by-compound search, to include a single additional species. That species is defined when: X=N; n=1; R<sup>1</sup>=H; R<sup>2</sup>=H, H, C<sub>1</sub> alkyl substituted by aryl; R<sup>3</sup>=halo and Z=F. A rejection follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11, in so far as it reads on the species defined above, is rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Biochemistry* (1971), 10(25), p. 4813-20 (CAPLUS abstract). The reference teaches applicant's compound: RN=35373-60-5.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the definition of  $R^2$ , it is unclear what type of moiety an saturated or *unsaturated*  $C_{1-8}$  alkyl group might be. This is particularly so since similar, yet unambiguous, language appears in the definition of  $R^3$  "...saturated or unsaturated  $C_{1-4}$  alkyl, *alkenyl*, *alkynyl*...". That is, what is an unsaturated alkyl group (as opposed to an alkenyl or alkynyl group)?

This rejection should have been included in the previous Office Action. The examiner regrets the error.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
May 5, 2004